

USSN: 10/686,997

- 6 -

Attorney Docket No: 3087.00012

REMARKS

Claims 1-3, 5-8, and 10-20 are currently pending in the application. Claims 1, 14, 19, and 20 have been amended. Support for the amendment can be found throughout the specification and specifically on page 4 ("The containers [containing the marked grid] can be used to store vials at room temperature and in a refrigerator, a freezer and a cryogenic (i.e., liquid nitrogen) storage tank") and page 6 ("A spreadsheet 24 corresponds to each container 12, either on a sheet of paper or on a screen on a computer. ... After entering contents of each vial stored in a container in the proper space 26, the spreadsheet 24 is kept as a file. When looking for a previously stored vial, entry of the vial in the spreadsheet 24 is searched and color of the container and location of the cell in the container is identified."). In other words, the spreadsheet is located in a separate physical location than the marked grid because one has to look for the container after identifying the spreadsheet. Claims 1, 14, 19, and 20 are in independent form.

Claims 1-3, 5-8, 10, and 14-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0116845 to Glover in view of U.S. Patent Nos. 5,842,179 to Beavers, et al. and 3,628,260 to Jacobsen. Specifically, the Office Action holds that Glover discloses a marked grid including specific locations 16 and a spreadsheet 22 including designations relating to the locations on the marked grid, such that each of the designations includes details regarding items located in each of the locations. However, the locations on the grid are identified by number, rather than by row and column. Beavers, et al. teaches that it was known in the art to identify locations in a grid by row and column, and therefore it would have been obvious to identify locations on the grid and corresponding spreadsheet of Glover by row and column as taught by Beavers, et al. The spreadsheet of Glover does not include a geometric grid corresponding to rows and

USSN: 10/686,997

- 7 -

Attorney Docket No: 3087,00012

columns. Jacobsen teaches that it was known in the art to provide a spreadsheet that physically corresponds to the grid it represents. Therefore, it would have been obvious to make the spreadsheet of Glover physically correspond to the rows and columns of a marked grid as taught by Jacobsen.

The Office Action holds in response to Applicant's previous argument that Beavers, et al. in Figure 6 discloses a grid in which the rows and columns are labeled in a linear progression and Jacobsen is cited merely for the teaching that it was known in the art to provide a spreadsheet, the rows and columns of which correspond geometrically to the rows and columns of a physical grid, in order to assist locating items on that grid. The Office Action holds that another well-known example of such a spreadsheet and grid combination is a Whitman's Sampler box. The Office Action further holds that the test for obviousness is whether the references (or the knowledge generally available to a person of ordinary skill of the art) suggest making the combination, not whether they also suggest achieving all of the advantages as the present invention. Reconsideration of the rejection under 35 U.S.C. §103(a), as being unpatentable over the Glover patent application, and the Beavers, et al. and Jacobsen patents is respectfully requested.

"Obviousness 'cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination.'" *In re Bell*, 991 F.2d 781, 783 (Fed. Cir. 1993) (citing *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1598, citing *ACS Hosp. Sys. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

Glover discloses an apparatus 10 including a plurality of storage compartments 16 for storing objects therein. A master list 22 "correlates to the compartments 16" and includes a set of information relating to the identity of the item

USSN: 10/686,997

- 8 -

Attorney Docket No: 3087,00012

for easy retrieval within the apparatus. Glover, paragraph [0018]. The spreadsheet is not a matching dimensional arrangement corresponding to the location of items in the apparatus, but rather a description of each item so that it can be easily found upon recognition and location of the item I.D, i.e. an inventory. The items are not ordered in columns according to their description, color, size, and brand name as displayed in the master list 22. Instead, the items are located in the compartments according to the item I.D. that can be numbered and ordered in any way. For example, item 6 could be found in a first column, second column, etc. of the apparatus. Thus, the spreadsheet of Glover does not provide or suggest a geometric location corresponding to an item.

"If the basic reference alone does not render the claimed design unpatentable, design elements from other references in the prior art can be considered in determining whether the claimed design would have been obvious to one of skill in the art. In order for secondary references to be considered, however, there must be some suggestion in the prior art to modify the basic design with features from the secondary references." *In re Borden*, 90 F.3d 1570, 1575, 39 U.S.P.Q.2d 1524 (C.A.Fed.,1996). *L.A. Gear*, 988 F.2d at 1124, 25 USPQ2d at 1917; *In re Rosen*, 673 F.2d at 391, 213 USPQ at 350.

Glover is the primary, or basic, reference cited by the Office Action. Therefore, some suggestion to modify Glover must be present. There is no motivation to use a spreadsheet as claimed in the present pending independent claims. Glover discloses a simple box with a simple categorizing system. Based on the teachings of Glover, there should be no problem filling a freezer with boxes with only item I.D.'s, because the secondary descriptions can be used to confirm that the correct color or brand of an item has been selected once that item I.D. has been found. There is no reason to ascertain the position of an item in the box by a

USSN: 10/686,997

- 9 -

Attorney Docket No: 3087.00012

geometric designation of a spreadsheet corresponding to a geometric designation of the box before opening that box. There is no reason to give an item a first geometric designation and a second geometric designation so that one can quickly locate the item, as Glover teaches that one item designation that does not even correspond to a position is certainly enough to locate an item. Thus, there is no suggestion to modify Glover with any secondary reference.

Beavers, et al. discloses a rack 19 holding a plurality of boxes 21, each box 21 being divided into a plurality of positions 23a. As shown in Figure 6, each position 23a is identified by row 28 (letter) and location within the row (number 31). It was known in the art to identify locations in a grid by row and column. However, Beavers, et al. does not disclose or suggest a spreadsheet with matching dimensional arrangements corresponding to the location in the box 21. Rather, Beavers, et al., like Glover, discloses an information sheet describing the contents of a specific position 23a. There is no way to look at the contents of a box all at once, as each information sheet only describes one position. Furthermore, there is no indication from Beavers, et al. that the method and apparatus disclosed therein are inadequate for use with laboratory refrigerators and freezers, and thus there is no motivation or suggestion to modify Beavers, et al. to use the spreadsheet of the present invention.

Jacobsen discloses a kit for enabling a user to mix colors to achieve a predicted color. Figure 2 shows the kit consisting of a cabinet including a base 20 and cover 22. Within the base 20 are a series of racks 26 for holding oil base pigment tubes 28. The tubes 28 of any row 30 have the same value (i.e. lightness and darkness such as "9" in Row 1 of Table 1). Each column 32 is a different color (Y, BP, R, and G). A chart 33 having rows and columns of blocks corresponding to the rows and columns of tubes 28, as shown in Figure 2 and Table 1. The rows and columns of the chart 33 do not geometrically correspond to the tubes 28 in the racks

USSN: 10/686,997

- 10 -

Attorney Docket No: 3087,00012

26. For example, Row 1, Column 1 corresponds to "Y 9/12". In other words, it is really row of value 9, column Y which corresponds to the tube of Y 9/12. There is no way to systematically identify a tube 28 within the racks 26. There is no order to columns Y, BP, R, and G. Contrary to the Office Action's statement above that "Jacobsen is cited merely for the teaching that it was known in the art to provide a spreadsheet, the rows and columns of which correspond geometrically to the rows and columns of a physical grid", Applicant again points out that the designations of Jacobsen are not geometric designations, unlike the series 1, 2, 3... or A, B, C, etc as required by the presently pending independent claims. Identification of the color of the material contained within the tube 28 by the chart 33 is achieved by looking horizontally and comparing the order of Y, BP, R, and G written in the bottom part of the base 20, counting the position from the left or right side of the chart 33 and reading the Y, BP, R, and G written in the bottom part of the base 20 and identifying from the chart 33, and then by looking vertically by counting the position from the top or bottom of the chart 33 and counting the same in the base 20. Thus, the spreadsheet of Jacobsen does not disclose a spreadsheet including a geometric grid thereon corresponding to first and second geometric dimensions of a marked grid with a matching dimensional arrangement as required by the independent claims.

That the Office Action likens a Whitman's Sampler box to the teachings of Jacobsen, further shows the Office Action's misunderstand of what a geometric spreadsheet is and how it functions. A Whitman's Sampler box merely provides a sheet of paper indicating the location of a particular piece of chocolate by its name (such as milk chocolate or dark chocolate) and shape (circular, square, rectangle). There is no order or geometric designations to help a person locate the chocolate or indication of rows or columns. Location of a particular piece of chocolate is only accomplished by the eater's knowledge of shapes and types of chocolate in relation

USSN: 10/686,997

- 11 -

Attorney Docket No: 3087,00012

to the other pieces in the box, and if they are patient enough, they can find it. If the Office Action has ever seen the index card of the candy in a Whitman's Sampler box, such an analogy to the present invention would not be draw. Since Jacobsen does not disclose all of the elements of the independent claims, especially a spreadsheet with corresponding geometrical designations to the geometric designations of a marked grid, combining Jacobsen with Glover and Beavers, et al. would still not arrive at the present invention.

Furthermore, it would not be obvious to combine Jacobsen, Glover, and Beavers, et al. because there is no suggestion to perform one of the advantages of the present invention, identifying the position of an object from within a closed container. The independent claims have been amended to recite that the spreadsheet is in a separate physical location than the marked grid. Neither Glover nor Beavers, et al. discloses a method for positionally recognizing where a compartment is from a spreadsheet. Jacobsen also does not disclose such a method. The chart 33 of Jacobsen is located inside the cover 22 of the cabinet. Because there are not any geometric dimensions of a spreadsheet corresponding to a marked grid, only after opening the cabinet and comparing the chart 33 to the base 20 can one find a desired tube 28. This takes time and in a freezer or refrigerator can be harmful to the person searching for a sample and the samples themselves. In contradistinction, because of the geometric dimensions of the spreadsheet corresponding to a marked grid of the present invention, and the location of the spreadsheet outside of the box and rack where samples are, one can find a sample quickly and efficiently. "Knowing in advance the location of the vial in a refrigerator or a freezer saves effort of a user and minimizes loss of energy used to keep a refrigerator and a freezer at cold temperature" (see specification page 6, lines 25-27).

USSN: 10/686,997

- 12 -

Attorney Docket No: 3087,00012

While Applicant's invention may seem to be a simple solution to the particular problems with which Applicant has faced, it is certainly novel and not disclosed or suggested in the prior art. The Office Action is essentially applying hindsight in order to arrive at the present invention, which is impermissible. There is no motivation or suggestion in the references to combine the elements required of Applicant's invention, and none of the references teach a spreadsheet as required by the presently pending independent claims.

"It is impermissible to first ascertain factually what appellants *did* and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct appellants' invention from such prior art." *In re Shuman*, 361 F.2d 1008, 1012, 150 USPQ 54, 57 (CCPA 1966).

"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention." *In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

There is no motivation in Glover, Beavers, et al. or Jacobsen, either alone or in combination, to provide a spreadsheet with corresponding geometric dimensions to a marked grid that allows quick identification of a sample. Therefore, the independent claims of the present invention requiring a spreadsheet including a geometric grid thereon corresponding to first and second geometric dimensions of a marked grid, and the spreadsheet being in a separate physical location than the marked grid are patentable over the combination of Glover, Beavers, et al. and Jacobsen.

USSN: 10/686,997

- 13 -

Attorney Docket No: 3087,00012

Since neither the cited references alone or in combination with knowledge in the art suggest the currently claimed invention, it is consequently respectfully submitted that the claims are clearly patentable over the combination, even if the combination were to be applied in opposition to applicable law, and reconsideration of the rejection is respectfully requested.

Claims 11-13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0116845 to Glover in view of U.S. Patent Nos. 5,842,179 to Beavers, et al. and 3,628,260 to Jacobsen as applied to claim 1, and further in view of U.S. Patent No. 6,352,286 to MacWilliams, et al. Specifically, the Office Action holds that Glover discloses the invention substantially as claimed but the indicia on the grid and spreadsheet do not include a barcode. MacWilliams, et al. teaches that it was known in the art to include a barcode along with other identifying indicia, in order to make the indicia machine-readable. Therefore, it would have been obvious to provide a barcode along with the other indicia disclosed by Glover as taught by MacWilliams, et al., in order to make the indicia machine-readable. Reconsideration of the rejection under 35 U.S.C. §103(a), as being unpatentable over the Glover patent application, and the Beavers, et al., Jacobsen, and MacWilliam, et al. patents is respectfully requested.

As stated above, Glover, Beavers, et al., and Jacobsen, alone or in combination, neither disclose nor suggest the present invention and the requirement of the independent claims of a spreadsheet including a geometric grid thereon corresponding to first and second geometric dimensions of a marked grid with a matching dimensional arrangement, wherein the spreadsheet is in a separate physical location than the marked grid. Combining these references with MacWilliams, et al. would still not arrive at the present invention. Since neither the cited references alone or in combination with knowledge in the art suggest the

USSN: 10/686,997

- 14 -

Attorney Docket No: 3087.00012

currently claimed invention, it is consequently respectfully submitted that the claims are clearly patentable over the combination, even if the combination were to be applied in opposition to applicable law, and reconsideration of the rejection is respectfully requested.

The remaining dependent claims are all ultimately dependent upon at least one of the independent claims discussed above. No prior art reference makes up for the deficiencies of that reference, as no prior art reference discloses the characterizing features of the independent claims as set forth above. The present invention can only be derived from the prior art through hindsight by further modifying one, if not all, of the prior art references in order to derive the positional identification capability of the independent claims. Hence, it is respectfully submitted that all depending claims are patentable over the prior art.

In view of the present amendment and foregoing remarks, reconsideration of the rejections and advancement of the case to issue are respectfully requested.

USPN: 10/686,997

- 15 -

Attorney Docket No: 3087.00012

The Commissioner is authorized to charge any fee or credit any overpayment in connection with this communication to our Deposit Account No. 11-1449.

Respectfully submitted,

KOHN & ASSOCIATES, PLLC

DRAFT

Kenneth I. Kohn, Reg. No. 30,955
Customer No.:

Dated: August 17, 2007

CERTIFICATE OF ELECTRONIC FILING VIA EFS-WEBDate of Electronic Filing:

I hereby certify that this correspondence is being electronically filed with the United States Patent & trademark Office on the above date.

Connie Herty